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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group No.: 1755

Examiner .: --

In re application of: HIROSEI MO, et al.

Serial No.: 10/009,070

Filed: December 7, 2001

For:

INK COMPOSITION

Attorney Docket No.: U 013765-3

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sirs:

REQUEST FOR REFUND

Deposit Account 12-0425 was changed \$180.00 for submission of Information Disclosure Statement (Fee Code 1800) on September 17, 2003 (Ref Txt No. 10009070).

However, the Information Disclosure Statement was mailed to the Patent Office on September 12, 2003 well within the this month mailing date of June 26, 2003 of the European Search Report and it was accompanied by the Statement. Attached are copies of the European Search Report and the Statement.

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this per plong with my paper referred to as being attached or enclosed) is being deposited with the United States Postal on the date shown below with sufficient postage as first classical in an anyelope addressed to the: Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450.

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(Type or rotte name of person mailing paper)

Date: March 10, 2004

of person mailing paper)

STATUS AND ENTITY BRANCH

Refund of the \$180.00, by credit, to Deposit Account 12-0425 is requested 143 17 Fil 4: 39

Respectfully submitted,

CLIFFORD J. MASS

LADAS & PARRY

26 WEST 618T STREET

NEW YORK, NEW YORK 10023 REG. NO. 30,086 (212) 708-1890

ditioner's Docket No. <u>U013766</u>

ATTENT AND TRADEMARK OFFICE 2004 MAR 17 PM 4: 39

HIROSHI ITO, ET ÂL. In re application of:

Application No.: 10/009,070 Filed: DECEMBER 7, 2001

INK COMPOSITION For:

Group No.: 1755 Examiner:

Commissioner for Patents P. O. Box 1450 Alexandria, VA 22313-1450

STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. SECTION 1.97(e)

NOTE: A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure of coment was known to any individual designated in Section 1.56(c) more than three months prior to the filling of the information disclosure statement." 37 C.F.R. Section 1.97(e).

Under the first statement under § 1:97(e), it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month parted in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. See § 609B(5), M.P. E. P., 8th Edition.

> CERTUPICATION UNDER 37 CF.R. 1.8(a) and 1.10° (When using Express Mail, the Express Mail label number is mandatory; Express Mail carification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. 1.8(n)

Date: September 12, 2003

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with sufficient postage as first class mail

37 C.F.R. 1.10°

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 Only the date filing (§ 1.6) will be the date used in a postent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continue to be taken tisto account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addresses" (§ 1.10) or facestmile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment ecleutations,

The statements. One statement is that each alted the search raport from a patent office outside "Section 1.97(e) makes is clear that a d the U.S. not more than three manter profits files describe interested. Under this optification, it would not NOTE: matter whether any individual will account any income character of enjoyments and organization contained in the information report. In the alternative, the coefficient account of information contained in the information The latter past is official a counterpart foreign application the argue after malding reasonable inquiry, was known to any disclosure statement was cited in a conindividual having a duty to discloss in a least three more right to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (anythin three months three motter prior to the filing of the statement. " Notice of January of being cited in a communication from Exercisin patent office in a counterpart foreign application, the certification

can be properly made regardless of any individual's previous knowledge of the information." Id., 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8 Edition. "The date on the communication by the fording poems office bagins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shorecased matutory pariod for reply. If the communication contains two dates, the mailing date of the commendation is the one which begins the 3-month period. The date which begins the NOTE: 3-month period is not the date the construction train stivid by a foreign associate or the date it was received by a U.S. registered practitioner. Litywise, the state sent will be considered to have been filed on the date the statement was received in the Office, or an an earlier does of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.P.R. 1.10. Sea § 6.9B(5), M.P.E.P., 8th Edition.

"The certification can be based on pros 3. Box fatility only dge about when information became known without a search of files being made. Thus, for assisting the gradient of § 1.97(e) does not preclude the use of the certification in an application by corporations whose progrationers have over the years reviewed thousands of patents NOTE: and technical publications even though that are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, et 19.

See § 609B(5), M.P.E.P. & Edition:

"If an information disclosive for the leaders a copy of a dated communication from a foreign patent office which clearly shows the first the state of the being submitted within 3 months of the date on the communication, the copy will access self irequired communication. It will be assumed, in the absence of evidence to the conserv, that the cost the cost was for a counterpart foreign application.

In the alternative, a steer most contained if no item of information contained in the information disclosure statement was clear in a counterpart foreign application a foreign patent office in a counterpart foreign application and, to the knowledge of the scan significant the statement after making reasonable inquiry, neither was it known to any individual having a duty to exclose more than 3 months prior to the filing of the statement."

A copy of the foreign see reviewed not be submitted with the certification. Notice of April 20, 1992 NOTE: (1138 O.G. 37-41, 40).

"The phrase 'after melting the certification has a duty to make resistance of the phrase of the phrase it clear that the individual making the certification can be has a duty to make resistance of the phrase of the facts that are being cartified. The certification can be made by a registered process a foreign client and who relies on statements made by the foreign client as to the deep to the phrase of the phrase of the phrase of the information was known for more than three marks however. NOTE: information from a an application without making reasonable inquiry. For example, if an months, however, actually the new fine without making reasonable inquiry. For example, if an inventor gave a public of the cited to the inventor gave a public of the cited to the cited to the office, the attorney making in a public of the cited inventor became aware of the publication and should office, the attorney making a public of the cited inventor became aware of the publication and should office, the attorney making a public of the cited inventor became aware of the publication and should office, the attorney making a public of the cited to 17 C.P.D. J. 97(e)(2) to the Office sait a satisfactory response is received. office, the unit to 37 C.F.R. 1.97(c)(2) to the Office that a satisfactory not submit a certification of 37 C.F.R. 1.97(c)(2) to the Office that a statisfactory not submit a certification can be supported by the statisfactory of the certification can be supported by the statisfactory of the certification can be supported by the statisfactory of the certification o without a search of the

See § 609B(5), M.P.E.P., 6 Witton.

first actually bocomes aware of the information in the "Although I Is The named of such a moded, the modeling date of such a mould determine the date NOTE: for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (camphasis added).

NOTE: The mare absence of en to of later of part of loss communication is not intended to represent an opposition of a later of a later of a later of an information of a later of an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53.

produced in the PTO, or on an earlier date of mailing of transmission if done so with the provisions for Express Mail" delivery under 37 C.F.R. § 1.8, or if it is income the first that the provisions for Express Mail" delivery under 37 C.F.R. § 1.10. See § 609B(3), M.P. I.F. & Edition. NOTE:

"The certification under Section 3.97(e) should be made by a person who has knowledge of the facts being certified. The certification continues to by a presittle or who represents a foreign client and who relies on statements made by the for it melions co to the design the information first became known. A practitioner who NOTE: receives information from a chast without battle informed whether the information was known for more than three months, however, carnot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

"The term counterpart fordist material explication means that a claim for priority has been made in either the U.S. application or a food of a food of the second on the other, or that the disclosures of the U.S. and foreign patent applications ero sells and dry deatical (e.g., an application filed in the European Patent NOTE: Office claiming the same U.E. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

"Individuals other then the attorney equal of toventer may comply with this section by disclosing information to the attorney, again or inventor, 37 C.F.R. Section 1.56(d) and NOTE:

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(2) each attorney or agent the project of projection in the application of the application (3) every other person who is substantively throlved in the preparation or prosecution of the application and who is associated with the law near with the assignee or with anyone to whom there is an obligation to assign the application \$7 C.F.R. Szence 1.56(c)

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1.	This statement is being made for [X] accompanying this statement		7.3	:		
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	Date .	خارز است				•

2. I, the person(s) signing below to

that each item of information contained in the information disclosure statement was filest cited in a communication from a lorging perent office in a counterpart foreign application not more than three months prior to the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

The three month period starts for the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-29 at 19 4.7 million data is the "date on the communication by the foreign patent office." NOTE: Notice of April 20, 1992 (1130 O.G. 37-41, 39).

d and inform for divelosure statement was cited in a propertion and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure Towart. 37 C.P.R. Section 1.97(c)(2)

NOTE:

3.

"The time at which information was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

identification of Person(s) making this statement

IDENTIFICATIO	or Perso	PM(6) MIAIAIING II IIII S 2.1222
The person making this state	ment is	
-		h applicable item)
(a) [] the inventor(s) who	signs below	
		SIGNATURE OF INVENTOR
		(type name of inventor who is signing)
(b) [] a person who is sub- and who is associat is an obligation to a	stantively invol ed with the inv ssign the applic	ived in the preparation or prosecution of the application, entor, with the assignee, or with anyone to whom there cation (37 C.F.R. Section 1.56(c)) and who signs below.
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Reg. No. 30,086		CLIFFORD J. MASS (type or print Jame of practitioner)
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LACK OF UNITY OF INVENTION

Application Number

EP 01 92 1813

The Search Division considers that the present European potent application does not comply with the requirements of unity of invention and retained to several inventions or groups of inventions, namely:

1. Claims: 1-12

Ink composition comprising a colorant, a humectant, a glycol monoether, an 1,2-alkanediol and water.

2. Claims: 13-32

Ink composition comprising a pigment, a dispersant for the pigment, an 1,2-alkanediol and water.

ANNEX TO THE EUROPEAN SEARCH REPORT ON EUROPEAN PATENT APPLIESTION NO.

EP 01 92 1813

िया goodman odtad in tha chove-mantionad European search report. ब्या देविन दिव वर्षा ब्या क्षेत्रका प्रतिको देव स्थापने given for the purpose of Information. This ennex lists the patent family members on the patent family members are as contained in the European Patent Office is in no way liable to 16-06-2003

Patent document		ProConcon	1	Potent family momber(0)	Publication date
dted in ceerch repo	A	25-11-1998	US CM EP TH	6538049 B1 1201057 A 0879858 A2 464677 B	25-03-2003 09-12-1998 25-11-1998 21-11-2001
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EP 0761783	A	12-03-1997	DE DE EP JP US US	69616914 D1 69616914 T2 0761783 A2 10095941 A 6004389 A 5746818 A	20-12-2001 04-04-2002 12-03-1997 14-04-1998 21-12-1999 05-05-1998
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